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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/582,402	11/10/2000	Peter Paul Polit	RCA88820	1656
24498	7590	01/24/2005	EXAMINER LY, ANH VU H	
PATENT OPERATIONS THOMSON LICENSING INC. PO BOX 5312 PRINCETON, NJ 08543-5312			ART UNIT 2667	PAPER NUMBER

DATE MAILED: 01/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/582,402

**Applicant(s)**

POLIT ET AL.

**Examiner**

Anh-Vu H Ly

**Art Unit**

2667

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Response to Amendment***

1. This communication is in response to applicant's amendment filed September 22, 2004.  
Claims 1-5 are pending.

***Claim Objections***

2. Claim 2 is objected to because of the following informalities: in line 1, "associated called ID" should be changed to - -associated caller ID- -. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-5 are rejected under 35 U.S.C. 102(e) as being anticipated by Oyama et al (US Patent No. 6,108,329). Hereinafter, referred to as Oyama.

With respect to claim 1, Oyama discloses (col. 6, line 53 – col. 7, line 6) that in receipt of the call approval, the terminal T11 gives a desired destination address such as terminal T21 (initiating an Internet voice call to a called device). The server S21 of the computer network NET21 dials the telephone number of the terminal T21 obtained from the database DB21 to call up the terminal T21. Herein, the server S21 already determined that the terminal T21 is off-line, otherwise, it would not dialed the terminal T21 (determining whether the called device is already connected to the Internet and initiating a PSTN telephone call to the called device if the called device is not already connected to the Internet). Oyama discloses in Fig. 11B, the destination terminal obtains information on the origination terminal ST23. Wherein, the information on the source terminals (col. 9, lines 41-44) that may include names of the source terminals (caller ID information), dates, etc...(initiating the PSTN call with associated caller ID information). Oyama discloses in Fig. 11B, that the communication through the Internet is established in ST28 after obtaining and viewing the information on the origination terminal (connecting the called device to the Internet in response to the associated caller ID information).

With respect to claim 2, Oyama discloses (col. 9, lines 41-44) that the information on source terminals may include names of the source terminals, countries of the source terminals, dates and times of dispatch, dates and times of arrival, and so forth (wherein the associated called ID information is a predetermined caller ID number).

With respect to claim 3, Oyama discloses (col. 6, line 53 – col. 7, line 6) that in receipt of the call approval, the terminal T11 gives a desired destination address such as terminal T21

Art Unit: 2667

(initiating an Internet voice call to a called device). The server S21 of the computer network NET21 dials the telephone number of the terminal T21 obtained from the database DB21 to call up the terminal T21. Herein, the server S21 already determined that the terminal T21 is off-line, otherwise, it would not dialed the terminal T21 (determining whether the called device is already connected to the Internet and initiating a PSTN telephone call to the called device if the called device is not already connected to the Internet). Oyama discloses (col. 8, lines 56-58) that a call through the modem and a call through a usual telephone can be discriminated by receiving a European calling tone from a server (initiating a PSTN telephone call with a distinctive ringing pattern). Oyama discloses (col. 9, lines 20-25) that if the call is determined to be from an acceptable terminal, it is judged whether the handset is picked up and communication is started within a predetermined time (connecting the called device to the IP network in response to the distinctive ringing pattern).

With respect to claim 4, Oyama discloses (col. 8, lines 56-58) that a call through the modem and a call through a usual telephone can be discriminated by receiving a European calling tone from a server (wherein the distinctive ringing pattern is different from the ringing pattern of a regular PSTN telephone call).

With respect to claim 5, Oyama discloses in Fig. 5, that the server determines PPP connection IP address and notifies IP address to the origination terminal, if necessary ST4. This implies that the destination terminal is already connected to the Internet, the communication can start right away (receiving an IP voice call through an IP network, if the receiving device is

Art Unit: 2667

connected to the IP network). Oyama discloses in Fig. 11B, the destination terminal obtains information on the origination terminal ST23. Wherein, the information on the source terminals (col. 9, lines 41-44) that may include names of the source terminals (caller ID information), dates, etc...(initiating the PSTN call with associated caller ID information) (receiving a PSTN telephone call with comprising caller ID information through a PSTN line). Oyama discloses in Fig. 12 that whether the information on the originating terminal should be rejected based on comparison (comparing the received caller ID information with a predetermined caller ID information, when caller ID information is received). Oyama discloses in Fig. 11B, that the communication through the Internet is established in ST28 after obtaining and viewing the information on the origination terminal (connecting through the IP network to establish the IP voice call in response to the received caller ID information that matches with the predetermined caller ID information).

### ***Response to Arguments***

4. Applicant's arguments with respect to claims 1-5 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***


5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anh-Vu H Ly whose telephone number is 571-272-3175. The examiner can normally be reached on Monday-Friday 7:00am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chi Pham can be reached on 571-272-3179. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2667

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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